UNITED STATES PATENT AND TRADEMARK OFFICE

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DUANE MORRIS LLP
IP DEPARTMENT (TSMC)
30 SOUTH 17TH STREET
PHILADELPHIA, PA 19103-4196

EXAMINER
WASSUM, LUKE S

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>23 August 2007</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-19,21,22,25-31,33-36,38 and 39</u> is/are pending in the application.

    4a) Of the above claim(s) <u>1-18</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>19,21,22,25-31,33-36,38 and 39</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>10 July 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   The Applicants' amendment, filed 23 August 2007, has been received, entered into the record, and considered.

2.   As a result of the amendment, claims 35, 36, 38 and 39 have been amended. Claims 20, 23, 24, 32 and 37 have been previously canceled. Claims 1-19, 21, 22, 25-31, 33-36, 38 and 39 are currently pending in the application, although claims 1-18 have previously been withdrawn from consideration as being drawn to a non-elected invention.

The Invention

3.   The claimed invention is a method and system for performing a citation search on a patent database. In one embodiment, the query engine performs a query expansion function on an assignee in order to identify patents which are commonly owned while having non-identical assignees.

Claim Rejections - 35 USC § 101

4.   In view of the amendment to claims 35, 36, 38 and 39, the pending claim

rejections under 35 U.S.C.§ 101 have been withdrawn.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   The factual inquiries set forth in *Graham* **v.** *John Deere Co.,* 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

7.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the

various claims was commonly owned at the time any inventions covered therein were

made absent any evidence to the contrary. Applicant is advised of the obligation under

37 CFR 1.56 to point out the inventor and invention dates of each claim that was not

commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

8.   Claims 19, 27, 28, 30 and 35 are rejected under 35 U.S.C. 103(a) as being

unpatentable over **Rivette et al.** (U.S. Patent 5,991,751) in view of **Getchius et al.** (U.S.

Patent 6,393,415).

9.   Regarding claim 19, **Rivette et al.** teaches a computer-based citation search

method substantially as claimed, comprising:

    a) receiving a search query, said search query comprising at least one patent

        identification condition (see disclosure of the various fields of search, col.

27, lines 14-32; see also drawing Figure 53, et seq.) and including a name of

an entity (see disclosure that the fields available to the user in the searching

window include assignee, col. 27, lines 14-32);

b) receiving a list of one or more patent databases (see disclosure of the scope of

search, col. 27, lines 1-13; see also drawing Figure 53 et seq.);

c) searching said list of patent databases to collect at least one first tier reference

patent that cites or is cited by patents satisfying said condition of said

search query (see extensive discussion of the Patent Citation module, col.

85, line 52 through col. 88, line 34; see also drawing Figures 61-65, 86 and

87); and

d) producing a citation list, said list identifying at least an owner of said first tier

reference patent in an electronically accessible medium (see extensive

discussion of the Patent Citation module, col. 85, line 52 through col. 88,

line 34; see also drawing Figures 61-65, 86 and 87; see also illustration in

drawing Figure 53 that the Assignee can be included in the list of search

results).

Rivette et al. does not explicitly teach a search method including automatically

using at least one additional name for searching, wherein said additional name is

obtained from an entity names table, and wherein said table identifies said additional

name as representative of said same entity, although **Rivette et al.** does disclose

addressing the identical problem through the pre-processing of patent information to

'normalize' variations of assignee names through the use of a thesaurus feature that lists

the most commonly used names for well-known companies, said thesaurus

corresponding to the claimed entity names table, col. 64, lines 16-31).

Getchius et al., however, teaches a search method wherein query terms are

expanded through the use of synonyms and other terms that are semantically related to

the term, such as expanding the term "City=New York" to also include "City=Brooklyn"

and "City=Queens" (see col. 35, lines 30-45).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to expand queries for entities [assignees] to include additional names

representative of the same entity [assignee], particularly in light of the fact that query

expansion in general was well known at the time of the invention (as evidenced by the

Getchius et al. reference), and also in light of the fact that **Rivette et al.** addresses the

identical problem (one assignee being referred to by multiple names), since this would

allow all documents associated with a given entity [assignee] to be accurately retrieved

even if they are represented in the database by different names, without the need to pre-

process all of the records in the database in order to normalize assignee data.

10.   Regarding claim 30, **Rivette et al.** teaches a computer-implemented system for

citation search substantially as claimed, comprising:

   a) means for receiving a search query, said search query comprising at least one

        patent identification condition (see disclosure of the various fields of

        search, col. 27, lines 14-32; see also drawing Figure 53, et seq.);

   b) means for identifying at least one entity (see disclosure that the fields available

        to the user in the searching window include assignee, col. 27, lines 14-32);

   c) means for receiving a list of one or more patent databases (see disclosure of the

        scope of search, col. 27, lines 1-13; see also drawing Figure 53 et seq.);

   d) means for searching said list of patent databases to collect at least one first tier

        reference patent that cites or is cited by patents satisfying said condition of

        said search query (see extensive discussion of the Patent Citation module,

        col. 85, line 52 through col. 88, line 34; see also drawing Figures 61-65, 86

        and 87); and

e) means for producing a citation list in an electronically accessible medium, said

list identifying at least an owner of said first tier reference patent (see

extensive discussion of the Patent Citation module, col. 85, line 52 through

col. 88, line 34; see also drawing Figures 61-65, 86 and 87; see also

illustration in drawing Figure 53 that the Assignee can be included in the

list of search results).

Rivette et al. does not explicitly teach a system including means for

automatically using at least one additional name for searching, wherein said additional

name is obtained from an entity names table, and wherein said table identifies said

additional name as representative of said same entity, although **Rivette et al.** does

disclose addressing the identical problem through the pre-processing of patent

information to 'normalize' variations of assignee names through the use of a thesaurus

feature that lists the most commonly used names for well-known companies, said

thesaurus corresponding to the claimed entity names table, col. 64, lines 16-31).

Getchius et al., however, teaches a system wherein query terms are expanded

through the use of synonyms and other terms that are semantically related to the term,

such as expanding the term "City=New York" to also include "City=Brooklyn" and "City=Queens" (see col. 35, lines 30-45).

It would have been obvious to one of ordinary skill in the art at the time of the invention to expand queries for entities [assignees] to include additional names representative of the same entity [assignee], particularly in light of the fact that query expansion in general was well known at the time of the invention (as evidenced by the **Getchius et al.** reference), and also in light of the fact that **Rivette et al.** addresses the identical problem (one assignee being referred to by multiple names), since this would allow all documents associated with a given entity [assignee] to be accurately retrieved even if they are represented in the database by different names, without the need to pre-process all of the records in the database in order to normalize assignee data.

11.   Regarding claim 35, **Rivette et al.** teaches a computer readable storage medium tangibly embodying a computer code, wherein, when the computer program code is executed by a processor, the processor performs a method of citation search substantially as claimed, comprising:

a) receiving a search query, said search query comprising at least one patent

identification condition (see disclosure of the various fields of search, col.

27, lines 14-32; see also drawing Figure 53, et seq.);

b) identifying at least one entity (see disclosure that the fields available to the

user in the searching window include assignee, col. 27, lines 14-32);

c) receiving a list of one or more patent databases (see disclosure of the scope of

search, col. 27, lines 1-13; see also drawing Figure 53 et seq.);

d) searching said list of patent databases to collect at least one first tier reference

patent that cites or is cited by patents satisfying said condition of said

search query (see extensive discussion of the Patent Citation module, col.

85, line 52 through col. 88, line 34; see also drawing Figures 61-65, 86 and

87); and

e) producing a citation list in an electronically accessible medium, said list

identifying at least an owner of said first tier reference patent (see extensive

discussion of the Patent Citation module, col. 85, line 52 through col. 88,

line 34; see also drawing Figures 61-65, 86 and 87; see also illustration in

drawing Figure 53 that the Assignee can be included in the list of search

results).

Rivette et al. does not explicitly teach computer program code including

automatically using at least one additional name for searching, wherein said additional

name is obtained from an entity names table, and wherein said table identifies said

additional name as representative of said same entity, although **Rivette et al.** does

disclose addressing the identical problem through the pre-processing of patent

information to 'normalize' variations of assignee names through the use of a thesaurus

feature that lists the most commonly used names for well-known companies, said

thesaurus corresponding to the claimed entity names table, col. 64, lines 16-31).

Getchius et al., however, teaches computer program code wherein query terms

are expanded through the use of synonyms and other terms that are semantically

related to the term, such as expanding the term "City=New York" to also include

"City=Brooklyn" and "City=Queens" (see col. 35, lines 30-45).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to expand queries for entities [assignees] to include additional names

representative of the same entity [assignee], particularly in light of the fact that query

expansion in general was well known at the time of the invention (as evidenced by the

Getchius et al. reference), and also in light of the fact that **Rivette et al.** addresses the

identical problem (one assignee being referred to by multiple names), since this would

allow all documents associated with a given entity [assignee] to be accurately retrieved

even if they are represented in the database by different names, without the need to pre-

process all of the records in the database in order to normalize assignee data.

12.   Regarding claims 27 and 28, **Rivette et al.** additionally teaches a computer-based

citation search method, wherein a second tier citation list is produced in an

electronically accessible medium based either on a forward citation analysis (the

claimed 'is cited by' search of claim 28) or a backward citation analysis (the claimed

'cites' search of claim 27), said second tier identifying at least an owner of said second

reference patent (see disclosure that recursive citation analyses may be performed, col.

87, line 47 through col. 88, line 3; see also illustration in drawing Figure 53 that the

Assignee can be included in the list of search results).

13.   Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Rivette et**

al. (U.S. Patent 5,991,751) in view of **Getchius et al.** (U.S. Patent 6,393,415) as applied to

claims 19, 27, 28, 30 and 35 above, and further in view of **Hammond** (U.S. Patent

7,139,755).

14.   Regarding claim 21, **Rivette et al.** and **Getchius et al.** teach a computer-based

citation search method substantially as claimed.

       Neither **Rivette et al.** nor **Getchius et al.** explicitly teaches a computer-based

citation search method further comprising translating query terms from a first content

language to a second content language, although **Rivette et al.** does teach a method

wherein said search query comprises at least one patent identification condition and

including a name of an entity (see disclosure that the fields available to the user in the

searching window include assignee, col. 27, lines 14-32).

       Hammond, however, teaches a method further comprising translating said

search query from a first content language to a second content language (see disclosure

of the language resolver, col. 7, lines 11-29).

It would have been obvious to one of ordinary skill in the art at the time of the invention to perform query expansion to include not only the user-entered query terms, but also foreign language translations of those terms, since this would ensure that documents using translations of terms (or even foreign language documents) will be retrieved in response to a user query.

15.   Claims 29, 34 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rivette et al.** (U.S. Patent 5,991,751) in view of **Getchius et al.** (U.S. Patent 6,393,415) in view of **Tanner et al.** (U.S. Patent Application Publication 2004/0243588).

16.   Regarding claim 29, **Rivette et al.** teaches a computer-based citation search method substantially as claimed, comprising:

a) receiving a search query, said search query comprising at least one patent identification condition (see disclosure of the various fields of search, col. 27, lines 14-32; see also drawing Figure 53, et seq.);

b) receiving a watch list, said watch list identifying at least one entity (see

disclosure of the various fields of search, including inventor and assignee

fields, col. 27, lines 14-32; see also drawing Figure 53, et seq.);

c) receiving a list of one or more patent databases (see disclosure of the scope of

search, col. 27, lines 1-13; see also drawing Figure 53 et seq.);

d) searching said list of patent databases to collect target patents satisfying said

condition set forth in said search query and whose owners match at least

one said entity identified in said watch list (see discussion of the Searching

module, col. 25, line 38 through col. 26, line 16 et seq.); and

e) searching said list of patent databases to collect reference patents that are cited

by target patents (see extensive discussion of the Patent Citation module,

col. 85, line 52 through col. 88, line 34; see also drawing Figures 61-65, 86

and 87).

Rivette et al. does not explicitly teach a search method including automatically

using at least one additional name for searching, wherein said additional name is

obtained from an entity names table, and wherein said table identifies said additional

name as representative of said same entity, although **Rivette et al.** does disclose

addressing the identical problem through the pre-processing of patent information to

'normalize' variations of assignee names through the use of a thesaurus feature that lists

the most commonly used names for well-known companies, said thesaurus

corresponding to the claimed entity names table, col. 64, lines 16-31).

Getchius et al., however, teaches a search method wherein query terms are

expanded through the use of synonyms and other terms that are semantically related to

the term, such as expanding the term "City=New York" to also include "City=Brooklyn"

and "City=Queens" (see col. 35, lines 30-45).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to expand queries for entities [assignees] to include additional names

representative of the same entity [assignee], particularly in light of the fact that query

expansion in general was well known at the time of the invention (as evidenced by the

Getchius et al. reference), and also in light of the fact that **Rivette et al.** addresses the

identical problem (one assignee being referred to by multiple names), since this would

allow all documents associated with a given entity [assignee] to be accurately retrieved

even if they are represented in the database by different names, without the need to pre-

process all of the records in the database in order to normalize assignee data.

Neither **Rivette et al.** nor **Getchius et al.** explicitly teaches a computer-based citation search method additionally generating a notice to a predetermined person when an owner of said reference patent matches a predetermined entity.

Tanner et al., however, teaches a method wherein a customer can submit a list of one or more items such as names or other pieces of information that a customer wants to constantly monitor and be notified if a potential match, direct match, or change in status information associated with the name or piece of information occurs (see paragraphs [0124] and [0252]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to implement notifications in the citation search system, since this allows a user to configure criteria wherein when said criteria is fulfilled, the user is notified, which allows the user to know immediately when such a criteria is found, instead of requiring an explicit search/query to be executed before the user finds out about the occurrence of said criteria.

17.   Regarding claim 34, **Rivette et al.** teaches a computer-implemented system for

citation search substantially as claimed, comprising:

      a) means for receiving a search query, said search query comprising at least one

          patent identification condition (see disclosure of the various fields of

          search, col. 27, lines 14-32; see also drawing Figure 53, et seq.);

      b) means for receiving a watch list, said watch list identifying at least one entity

          (see disclosure of the various fields of search, including inventor and

          assignee fields, col. 27, lines 14-32; see also drawing Figure 53, et seq.);

      c) means for receiving a list of one or more patent databases (see disclosure of the

          scope of search, col. 27, lines 1-13; see also drawing Figure 53 et seq.);

      d) means for searching said list of patent databases to collect target patents

          satisfying said condition set forth in said search query and whose owners

          match at least one said entity identified in said watch list (see discussion of

          the Searching module, col. 25, line 38 through col. 26, line 16 et seq.); and

      e) means for searching said list of patent databases to collect reference patents

          that are cited by target patents (see extensive discussion of the Patent

          Citation module, col. 85, line 52 through col. 88, line 34; see also drawing

          Figures 61-65, 86 and 87).

Rivette et al. does not explicitly teach a system including means for

automatically using at least one additional name for searching, wherein said additional

name is obtained from an entity names table, and wherein said table identifies said

additional name as representative of said same entity, although Rivette et al. does

disclose addressing the identical problem through the pre-processing of patent

information to 'normalize' variations of assignee names through the use of a thesaurus

feature that lists the most commonly used names for well-known companies, said

thesaurus corresponding to the claimed entity names table, col. 64, lines 16-31).

Getchius et al., however, teaches a system wherein query terms are expanded

through the use of synonyms and other terms that are semantically related to the term,

such as expanding the term "City=New York" to also include "City=Brooklyn" and

"City=Queens" (see col. 35, lines 30-45).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to expand queries for entities [assignees] to include additional names

representative of the same entity [assignee], particularly in light of the fact that query

expansion in general was well known at the time of the invention (as evidenced by the

Getchius et al. reference), and also in light of the fact that Rivette et al. addresses the

identical problem (one assignee being referred to by multiple names), since this would

allow all documents associated with a given entity [assignee] to be accurately retrieved

even if they are represented in the database by different names, without the need to pre-

process all of the records in the database in order to normalize assignee data.

Neither **Rivette et al.** nor **Getchius et al.** explicitly teach a computer-

implemented system for citation search additionally generating a notice to a

predetermined person when an owner of said reference patent matches a

predetermined entity.

Tanner et al., however, teaches a system wherein a customer can submit a list of

one or more items such as names or other pieces of information that a customer wants

to constantly monitor and be notified if a potential match, direct match, or change in

status information associated with the name or piece of information occurs (see

paragraphs [0124] and [0252]).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to implement notifications in the citation search system, since this allows a

user to configure criteria wherein when said criteria is fulfilled, the user is notified,

which allows the user to know immediately when such a criteria is found, instead of

requiring an explicit search/query to be executed before the user finds out about the

occurrence of said criteria.

18.   Regarding claim 39, **Rivette et al.** teaches a computer readable storage medium

tangibly embodying a computer program code, wherein, when the computer program

code is executed by a processor, the processor performs a method of citation search

substantially as claimed, comprising:

a) receiving a search query, said search query comprising at least one patent

identification condition (see disclosure of the various fields of search, col.

27, lines 14-32; see also drawing Figure 53, et seq.);

b) receiving a watch list, said watch list identifying at least one entity (see

disclosure of the various fields of search, including inventor and assignee

fields, col. 27, lines 14-32; see also drawing Figure 53, et seq.);

c) receiving a list of one or more patent databases (see disclosure of the scope of

search, col. 27, lines 1-13; see also drawing Figure 53 et seq.);

d) searching said list of patent databases to collect target patents satisfying said

condition set forth in said search query and whose owners match at least

one said entity identified in said watch list (see discussion of the Searching

module, col. 25, line 38 through col. 26, line 16 et seq.); and

e) searching said list of patent databases to collect reference patents that are cited

by target patents (see extensive discussion of the Patent Citation module,

col. 85, line 52 through col. 88, line 34; see also drawing Figures 61-65, 86

and 87).

Rivette et al. does not explicitly teach computer program code including

automatically using at least one additional name for searching, wherein said additional

name is obtained from an entity names table, and wherein said table identifies said

additional name as representative of said same entity, although **Rivette et al.** does

disclose addressing the identical problem through the pre-processing of patent

information to 'normalize' variations of assignee names through the use of a thesaurus

feature that lists the most commonly used names for well-known companies, said

thesaurus corresponding to the claimed entity names table, col. 64, lines 16-31).

Getchius et al., however, teaches computer program code wherein query terms

are expanded through the use of synonyms and other terms that are semantically

related to the term, such as expanding the term "City=New York" to also include

"City=Brooklyn" and "City=Queens" (see col. 35, lines 30-45).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to expand queries for entities [assignees] to include additional names

representative of the same entity [assignee], particularly in light of the fact that query

expansion in general was well known at the time of the invention (as evidenced by the

Getchius et al. reference), and also in light of the fact that **Rivette et al.** addresses the

identical problem (one assignee being referred to by multiple names), since this would

allow all documents associated with a given entity [assignee] to be accurately retrieved

even if they are represented in the database by different names, without the need to pre-

process all of the records in the database in order to normalize assignee data.

Neither **Rivette et al.** nor **Getchius et al.** explicitly teach computer readable

medium with computer program code additionally generating a notice to a

predetermined person when an owner of said reference patent matches a

predetermined entity.

Tanner et al., however, teaches a system wherein a customer can submit a list of

one or more items such as names or other pieces of information that a customer wants

to constantly monitor and be notified if a potential match, direct match, or change in

status information associated with the name or piece of information occurs (see

paragraphs [0124] and [0252]).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to implement notifications in the citation search system, since this allows a

user to configure criteria wherein when said criteria is fulfilled, the user is notified,

which allows the user to know immediately when such a criteria is found, instead of

requiring an explicit search/query to be executed before the user finds out about the

occurrence of said criteria.

19.   Claims 22, 31 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable

over **Rivette et al.** (U.S. Patent 5,991,751) in view of **Getchius et al.** (U.S. Patent

6,393,415) as applied to claims 19, 27, 28, 30 and 35 above, and further in view of **Tanner**

et al. (U.S. Patent Application Publication 2004/0243588).

20.   Regarding claims 22, 31 and 36, **Rivette et al.** and **Getchius et al.** teach a

computer-based citation search method and system substantially as claimed.

        Neither **Rivette et al.** nor **Getchius et al.** explicitly teaches a computer-based

citation search method and system additionally generating a notice to a predetermined

person when an owner of said reference patent matches a predetermined entity.

        Tanner et al., however, teaches a method and system wherein a customer can

submit a list of one or more items such as names or other pieces of information that a

customer wants to constantly monitor and be notified if a potential match, direct match,

or change in status information associated with the name or piece of information occurs

(see paragraphs [0124] and [0252]).

        It would have been obvious to one of ordinary skill in the art at the time of the

invention to implement notifications in the citation search system, since this allows a

user to configure criteria wherein when said criteria is fulfilled, the user is notified,

which allows the user to know immediately when such a criteria is found, instead of

requiring an explicit search/query to be executed before the user finds out about the

occurrence of said criteria.

21.   Claims 25, 26, 33 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable

over **Rivette et al.** (U.S. Patent 5,991,751) in view of **Getchius et al.** (U.S. Patent

6,393,415) as applied to claims 19, 27, 28, 30 and 35 above, and further in view of **Dialog**

("Patent Research for Competitive Intelligence").

22.   Regarding claims 25, 26, 33 and 38, **Rivette et al.** and **Getchius et al.** teach a

computer-based citation search method, system and code substantially as claimed.

Neither **Rivette et al.** nor **Getchius et al.** explicitly teaches a computer-based

citation search method, system and code wherein the citation list identifies at least two

patents as being commonly owned by a single entity, wherein each of the at least two

patents specifies a different name of assignee, although **Rivette et al.** does teach a

computer-based citation search method, system and code further comprising referring

to said entity names table to identify said at least two patents that specify different

names of assignee as being commonly owned by said single entity (see disclosure of the

thesaurus feature that lists the most commonly used names for well-known companies,

said thesaurus corresponding to the claimed entity names table, col. 64, lines 16-31).

Dialog, however, teaches a computer-based citation search method, system and

code wherein the citation list identifies at least two patents as being commonly owned

by a single entity, wherein each of the at least two patents specifies a different name of

assignee (see illustration of a citation list which includes both the assignee, and an

assignee code, said code constituting the specific entity, while the assignee name

includes a number of name variants of the entity, page 3-14).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to include an indication that patents in a list are commonly owned, since this

is beneficial when performing competitive analysis, in order to gain insight into the

strategic positions held by competing companies.

Response to Arguments

23.   Applicant's arguments filed 23 August 2007 have been fully considered but they

are not persuasive.

24.   The Applicants argue that it would not have been obvious to perform query

expansion by using at least one additional name for searching when said additional

name is **obtained from an entity names table** (emphasis in original). The examiner

respectfully disagrees.

The **Getchius et al.** reference discloses the well-known practice of query

expansion, wherein a user submits query terms, and the system automatically adds

additional query terms that are closely related to the input term, such as synonyms.

This practice allows a user to receive not only results that correspond to the query term

explicitly entered by the user, but also results that may be closely related but might not

include the input term (see col. 35, lines 30-45).

The **Rivette et al.** reference discloses a system wherein a database of patents may

be searched. As part of the disclosed system, **Rivette et al.** addresses the problem

wherein different patents may be assigned to the same corporate entity, but have

different assignee names registered. In col. 64, it is disclosed that

> The error detection and correction module **4612** also
> detects for errors in the information in the patent text file
> **4604** corresponding to assignees. The same company can be
> listed as assignee in different patents using different names.
> 20 For example, IBM can be listed as the assignee in patents
> using various different names, such as IBM; International
> Business Machines; IBM, Inc.; etc. The error detection and
> correction module **4612** includes a thesaurus feature that
> lists the most commonly used names for well-known com-
> 25 panies. The error detection and correction module **4612**
> compares the assignee name from the patent text file **4604**
> with this thesaurus and replaces the assignee information in
> the patent text file **4604** with the name retrieved from the
> thesaurus. Alternatively, the name retrieved from the the-
> 30 saurus may be written to an appropriate user-defined field of
> the bibliographic databases **602.**

Thus, while the **Getchius et al.** reference addresses the problem through query

expansion, the **Rivette et al.** reference addresses the problem by normalizing the patent

(specifically, the patent assignee) data as it is entered into the database.

As part of the normalization process disclosed by the **Rivette et al.** reference, the

error detection and correction module compares the assignee name from the patent text

file with a thesaurus of the most commonly used names for well-known companies.

As stated in the rejection of record, this thesaurus constitutes the claimed entity

names table.

Also as stated in the rejection of record, it would have been obvious to an

ordinary artisan to utilize the thesaurus to perform query expansion, since this would

preclude the necessity to preprocess all of the data records being entered into the

database, while ensuring that different variants of corporate entities' names are used to

retrieve all patents assigned to a particular company.

Furthermore, the Courts have ruled that the combination of familiar elements

according to known methods is likely to be obvious when it does no more than yield

predictable results, which is clearly the case in this instance. See *KSR International Co. v.*

Teleflex Inc., 127 S.Ct 1727, 82 USPQ2d 1385 (2007).

The rejections of record are maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke S. Wassum whose telephone number is 571-272-4119. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Cottingham can be reached on 571-272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

In addition, INFORMAL or DRAFT communications may be faxed directly to the examiner at 571-273-4119. Such communications must be clearly marked as INFORMAL, DRAFT or UNOFFICIAL.

Customer Service for Tech Center 2100 can be reached during regular business hours at (571) 272-2100, or fax (571) 273-2100.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Luke S. Wassum
Primary Examiner
Art Unit 2167

lsw
18 October 2007